

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 August 2009 has been entered.

Claim Objections

Claims 1 and 4 are objected to because of the following informalities: Claim 1, line 6 and claim 4 lines 3-4 contained "message management module", but the specification does not contain message management module except "ad management module". Therefore, appropriate correction is required.

Claim 8 is objected to because of the following informalities: Claim 8 line 10 contains "the message delivery module" but the specification does not contain message delivery module except "ad delivery module". Therefore, appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. 101 because they are directed to nonstatutory subject matter.

Claim 7 is a method claim and as such must pass the "machine or transformation test". In accordance with the M-or-T test, the claimed process must: (1) be tied to a particular machine or apparatus (machine implemented); or (2) particularly transform a particular article to a different state or thing.

A method claim that does not require machine implementation or does not cause a transformation will fail the test and should be rejected under § 101. However, the mere presence of a machine tie or transformation is not sufficient to pass the test. When a machine tie or transformation has been identified, it must be further determined that the tie is to a particular machine or the particular transformation is of a particular article. Additionally, the particular machine tie or particular transformation must meet two corollaries to pass the test for subject matter eligibility. First, the use of the particular machine or transformation of the particular article must impose a meaningful limit on the claim's scope. So, a machine tie in only a field-of-use limitation would not be sufficient. Second, the use of the particular machine or the transformation of the particular article must involve more than insignificant "extra-solution" activity. If the machine or transformation is only present in a field-of-use limitation or in a step that is only insignificant "extra-solution" activity, the claim fails the M-or-T test, despite the presence of a machine or a transformation in the claim.

While these claims call for storing the identification of the product or service..., and the step storing the identification of the product inherently requires a particular machine, note that under the broadest reasonable interpretation no other step requires

a machine. Further, the setting up step is not central to the purpose of the method invented by the applicant and is insignificant extra-solution activity. Finally, there is no transformation and therefor the methods are not eligible.

Claims 1 and 8 are rejected under 35 U.S.C. 101 because the claimed elements contain a database for collection of information, modules and units, which are software. The claims have no physical structure. Software and collection of data do not fall within one of the four statutory classes.

Claims 2-6 and 9-12 are rejected under 35 U.S.C. 101 for being dependent upon claims 1 and 8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US 6,055,513) in view of Franco (US 7, 257,552 B1)

With respect to claims 1 and 7 Katz teaches a system and a method enabling conditional delivery of commerce-related information, comprising:

receiving from a user an identification of a product or service (**Fig. 4, 140**, where "caller" reads on user, **Fig. 8, 280** teaches ID, **Col. 2, 44-47**, which teaches prompting to enter the "item number" reads on identification of product to identify the goods and

service and Col. 25, line 11-22), wherein the product or service is the subject of a broadcast;

receiving from the user at least one condition under which the user desires to receive additional information relating to the product or service identified by the user (*Fig. 7, 242 where teaches collecting inputs for up sale computation and 260 teaches user makes decision, Col. 2, lines 43-47, which teach caller (user) entered an item number to identify the goods or service and Col. 18, lines 2-15)*;

receiving a user identification corresponding to the user (*Col. 21, lines 33-38, which teaches specific consumer identification such as user's Social Security number and Col. 22, lines 7-10, which teaches user identity obtained form the particular contact)*;

storing the identification of the product or service and the at least one condition in association with the user identification (*Col. 9, lines 5-21, which teaches transaction data includes product (Col. 2, 44-47 contained item number) purchase information, billing information and consumer identification number*)

after receiving additional information relating to the product or service, assessing whether the at least one condition is satisfied (*Fig. 7, 242, Fig. 10 and Col. 26, lines 4-11, which teaches customer satisfaction with the goods and service incorporated in the decision criteria reads on assessing whether the at least the condition is satisfied*); and

In addition to claim 7, Katz teaches additional limitation of claim 1, wherein a user account database storing use account information associated with plurality of users (*Fig. 6, 330 and Col. 9, lines 52-67 and Col. 10, line 1, which teaches database that*

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contained consumer profile and credit card information) and messaging database storing at least one message in association with the product (Col. 23, lines 40-50 which teaches a database that contain such as delivery status, inventory stats reads on a messages associated with a product).

Katz teaches the above elements as cited above, including receiving data from user after the receipt and use of their obtained goods or service, such as wherein the customer satisfaction with the goods and services, incorporated in the decision criteria **(Col. 26, lines 4-12).**

Katz does not teach conditionally providing the additional information to the user, if the at least one condition imposed by user is satisfied, deliver the message as to all user where the condition imposed by the users are satisfied scan the user account database to determine whether the at least one message satisfies the condition imposed by user.

Franco teaches conditionally providing the additional information to the user, if the at least one condition imposed by user is satisfied, deliver the message as to all user where the condition imposed by the users are satisfied scan the user account database to determine whether the at least one message satisfies the condition imposed by user **(Col. 24, lines 55-67 and Col. 25, lines 1-3, which teaches consumer imposed rules that satisfy consumer needs).** Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a feature that allows a consumer to outline his/her criteria as taught by Franco in the system of Katz since the claimed invention is merely a combination of old elements, and in the combination

each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With respect to claim 2, Katz in view of Franco teaches all elements of claim 1. Furthermore, Katz teaches a method further comprising a transaction processing system operative to receive product orders from users (**Fig.4, 140, which teaches order transaction entered by Caller (user))** and process payment transactions (**Fig. 5, 210, 212, where "billing" reads on processing payment and 214**) and .

With respect to claim 3, Katz in view of Franco teaches all elements of claim 1. Furthermore, Katz teaches a method further comprising a call center comprising at least one call station assisting a live agent to handle calls from users (**Fig. 3, 40 where teaches call center, 42, live operator, Col. 12, lines 39-44 and Col. 16, lines 23-31**) and .

With respect to claim 4, Katz in view of Franco teaches all elements of claim 1. Furthermore, Katz teaches a method further comprising:

an interactive voice response system to receive and transmit data over a telecommunications network (**Col. 16, lines 52-54 and Col. 26, lines 38-40, where "website" reads on telecommunications network**)

the interactive voice response system providing the interface by which users access the message management module (**Col. 27, lines 22-35, which teaches an interactive live response system**).

With respect to claim 5, Katz in view of Franco teaches all elements of claims 1 and 4. Furthermore, Katz teaches a method wherein the interactive voice response system includes automatic number identification (ANI) functionality, allowing identification of telephone numbers associated with incoming calls and wherein identified telephone numbers are used to identify users and retrieve user account information from the user account database(**Col. 9, lines 29-42, which teaches consumer identification number automatically supplied by (ANI)**).

With respect to claim 6, Katz in view of Franco teaches all elements of claim 1. Furthermore, Katz teaches a method wherein the at least one message is an electronic coupon (**Fig. 9, and Col. 27, lines 16-21, which teach electronic coupon provided to the user in a real time manner**).

With respect to claim 8, Katz in view of Franco addressed in claims 1 and 4. Additionally, Katz teaches a broadcast signal monitoring unit operative to detect message codes in a broadcast signal (**Fig. 9, Col. 17, lines 15-36, which teaches shipping/tracking unit (monitoring unit) to check on shipping or delivery information (detecting message) and Col. 27, lines 2-13, where teaches the existence of the "product/service" reads on message**).

With respect to claim 9, Katz in view of Franco teaches all elements of claim 8. Furthermore, Katz teaches a method wherein the broadcast signal is a television signal (**Col. 17, lines 23-27, which teaches television for direct broadcast**).

With respect to claim 10, Katz in view of Franco teaches all elements of claim 8, including broadcasting through Internet access, cable, television, direct broadcast,

satellite broadcast, e-mail facsimile, and voice mail or otherwise (**Col. 17, lines 23-27**). However, Katz does not explicitly teach radio signal. However, an official notice has been taken since its old and well known in broadcasting to use radio signals. Therefore, it would have been obvious to one ordinary skill in the art to include radio broadcasting feature in Katz's and Franco's invention in order to transmit advertisement message to a user (e.g., while the user is driving or traveling by car).

With respect to claim 11, Katz in view of Franco teaches all elements of claim 8. Furthermore, Katz teaches a method wherein the message is an electronic coupon (**Fig. 9, teach e-coupon, and Col. 27, lines 16-18, teaches an electronic coupon provided to the user in a real time manner**).

With respect to claim 12, Katz in view of Franco teaches all elements of claim 8. Furthermore, Katz teaches a method further comprising a user account database storing user account identifiers in association with at least one message delivery mode preference (**Fig. 6, 330, external database contain "credit" reads on account and Col. 23, lines 27-39, which teaches a credit verification, credit authorization for the amount equal and available credit (account) and Col. 7, lines 45-51**), and wherein the ad delivery module is operative to deliver the message to each user using the delivery mode specified in a corresponding user account (**Fig. 10, Col. 23, lines 40-50, which teaches delivery time and Col.27, lines 22-35**).

Response to Arguments

Applicant's arguments filed on 3 August 2009 have been fully considered but they are not persuasive.

Applicant argued in page 6 that there is no teaching or suggestion in the combination of "deliver the message as to all users where the condition imposed by the user is satisfied." However, the examiner respectfully disagree with the applicant because Katz teaches deliver message as to all users where the condition imposed by the user is satisfied (**Col. 2, lines 56-63, teaches delivery of coupons(message) to potential customers based on various factors, such as "geographic location, demographic data suspected socioeconomic status or other factors " reads on condition imposed by user)**

Applicant in page 6 argued that Franco's reference has to do with order fulfillment for merchandise order and has nothing to do with delivering message according to user-specified conditions and applicant admitted that combining Katz with Franco may have enhanced Katz's merchandise order fulfillment capability, but it would have no effect on Katz's ability to provide information regarding a product identifier, specified by user.

However, the examiner respectfully disagrees with the applicant because combination of Katz's reference and Franco's reference will provide the same result as they did separately for the following reasons:

a) Applicant admitted that combining Katz with Franco has enhanced Katz's merchandise order fulfillment capability.

b) While Katz teaches all elements of claims 1, 7 and 8, the limitation that was missing from Katz's reference is taught by Franco. Franco teaches conditionally providing the additional information to the user, if the at least one condition imposed by the user is satisfied (**Col. 15, lines 16-31**, teaches where "consumer receiving message indicating that the consumer order (e.g. book) has arrived" reads on delivering message and where "scheduled to pickup (e.g., on Friday at 5:25)" reads on rule imposed by customer **and Col. 24, lines 55-67 and Col. 25, lines 1-3**, teaches consumer imposed rules that satisfy consumer needs).

Additionally, applicant in pages 6 and 7 argued that claim 1 is amended to describe "receive, from a user, a product identifier and at least on condition under which the user desires to receive information associated with the product identifier received from the user". However the examiner respectfully disagrees with the applicant because the Katz teaches amended limitation "receive, from a user, a product identifier (**Col. 2, lines 44-47**, teaches the caller (user) prompt to enter the item number (product identifier) to identify the goods and service) and at least one condition under which the user desires to receive information associated with the product identifier received from the user" (**Col. 2, lines 47-54**, where "user entry of payment information, such as the entry of credit card number and typed of identifier" reads on at list one condition).

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does

not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, the following language in claims 1, and 6, was not given patentable weight:

Claim 1, "deliver the message as to all users where the conditions imposed by the user are satisfied.

Claim 7, "conditionally providing the additional information to the user, it the at least one condition imposed by the user is satisfied".

Even though, the Examiner has addressed the optional limitation in this action, it is the Examiner's opinion that this limitation do not distinguish the claim from the prior art. See MPEP 2106 II C (Paragraph 4+).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Weinhardt can be reached on (571) 272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/S. D./

Examiner, Art Unit 3688

/C. Michelle Tarae/

Primary Examiner, Art Unit 3688